

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed May 25, 2007. At the time of the Final Office Action, Claims 1-5, 7, 8, 10, 11, 13-23, 25 and 26 were pending in this Application and were rejected. Claims 6, 9, 12, 24 were previously cancelled without prejudice or disclaimer. Claims 1 and 8 have been amended to further define various features of Applicant's invention. Claim 25 has been cancelled without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §112

Claims 1-5, 7-8, 10-11, 13-23 and 25-26 were rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant traverses.

The office action contends that Independent Claim 1 is, "still unclear what the optic fiber is being independently advanced with respect to." Claim 1 recites "independently advancing at least one optic fiber through the access device and into a nucleus of the disc." The optic fiber is moved through the access device and into the nucleus of the disc. Also, the optic fiber is moved independent from any other device or apparatus used to treat the disc or access the disc. Thus, the optic fiber is advanced relative to both the access device (it is advanced through the access device) and the disc (it is advanced into the disc).

Accordingly, Applicant submits that Claim 1 and its dependent claims are not unclear and requests reconsideration and withdrawal of the rejections under section 112.

Rejections under 35 U.S.C. §102

Claims 1, 2, 4, 5, 10, 11, 13-20, 22-23, 25 and 26 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,277,112 issued to Underwood et al. ("Underwood"). Applicant respectfully traverses and submits that the cited reference does not teach each and every element of the claimed embodiment of the invention. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

As an initial matter, Independent Claim 1, as amended, recites, “advancing an access device into the disc, the access device comprising a needle.” While the cited embodiments (Figures 16-18) or Underwood include a cannula or trocar element 302 through which catheter 306 is introduced, cannula 302 only partially penetrates the patient (see Figure 16) and is not advanced into the disc. Instead, the relevant embodiment of Underwood discloses the insertion of a separate catheter 306 through the cannula which is then advanced into the disc. See Figure 18. Catheter 306 of Underwood is not a needle. Underwood also discusses that an additional instrument (a trephine) may be used to form a channel between the cannula and the disc. See Col. 27, lines 45-48. Accordingly, Underwood does not disclose a step of advancing a needle into the disc.

Additionally, the office action contends that the Underwood reference:

clearly discloses a plurality of inner lumens (not shown) in catheter body 306 that individually deliver the electrosurgical treatment device 310, endoscope 316, and other tools 314, 318 (col. 26, ln. 53-59, col. 26, ln. 63 –col. 27, ln. 8, and Figs. 16 and 17.) Since the optic fiber of the endoscope and the other tools are each separately advanced through a respective lumen, the optic fiber is inherently independently advanced with respect to the disc as argued.

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Applicant respectfully disagree with this conclusion and analysis. In the embodiment in question, multiple components pass through catheter 306: a) electrosurgical instrument 310, b) aspiration catheter 314, c) illumination fiber 318 and d) endoscope 316. Applicant notes that only electrosurgical instrument component 310 includes an assembly 330 “for controlling the axial travel distance T_D of the probe.” No such assembly is provided for separately controlling the axial travel of illumination fiber 318 and endoscope 316. Underwood discusses rotational and translation movement of working end 48 (Col. 27, lines 27-30) but does not discuss or disclose separate or independent translation of endoscope 316 and illumination fiber 318. Instead, lens 34 of endoscope 316 appears to be fixed at the distal end 346 of catheter body 306.

With respect to the endoscope embodiments of Figs. 12-15 of Underwood cited in the Office Action, the arguments above are equally applicable. Retractor 278 is not a needle and is

not advanced into the disc. Also, these embodiments relate to a traditional endoscope and not to an optical fiber and endoscope 280 is fixed with respect to tubular retractor 278. See Col. 24, lines 16-18.

For at least these reasons Applicant submits that Underwood cannot anticipate Independent Claim 1 or Claims 2, 4, 5, 10, 11, 13-20, 22-23, and 26 which depend therefrom. Applicant requests reconsideration, withdrawal of the rejections under Section 102 and allowance thereof.

Rejections under 35 U.S.C. §103

Claim 3, 7, 8 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Underwood. Applicant respectfully traverses and submits that, for the reasons discussed above, Claims 3, 7, 8 and 21 depend from claims that have been placed in condition for allowance and are not rendered obvious by Underwood. Applicant requests reconsideration withdrawal of the rejections under §103(a) and allowance of Claims 3, 7, 8 and 21.

Information Disclosure Statement

Applicant encloses an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.

Request for Continued Examination (RCE)

Applicant encloses a Request for Continued Examination (RCE) Transmittal, with authorization to charge Deposit Account No. 50-0359 of ArthroCare Corporation in the amount of \$790.00 for the RCE fee.

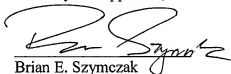
CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

The Commissioner is hereby authorized to charge any fees necessary for the extension of time, Request for Continued Examination or any additional fees or to credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.391.3961.

Respectfully submitted
Attorney for Applicant,


Brian E. Szymczak
Reg. No. 47,120

Date: 9/25/2007

SEND CORRESPONDENCE TO:

ARTHROCARE CORPORATION

CUSTOMER NO. **21394**

512.391.3961

512.391.3901 (fax)